

## **REMARKS**

Claims 1, 3-5, and 25 are amended. Claims 6-21 were previously canceled without prejudice or disclaimer. No new matter is added by these amendments. Claims 1-5 and 22-25 are pending. By amending and canceling the claims, applicant is not conceding that the claims are non-statutory under 35 U.S.C. 101, 102, 103, and 112 and is not conceding that the claims are unpatentable over the references cited by the Office Action, as the claim amendments are only for the purpose of facilitating expeditious prosecution. Applicant respectfully reserves the right to pursue the subject matter of the claims as it existed prior to any amendment or cancellation and to pursue other claims in one or more continuation and/or divisional applications. Applicant respectfully requests reconsideration and allowance of all claims in view of the amendments above and the remarks that follow.

### *Claim Rejections under 35 U.S.C. 101*

Claims 1-5 and 22-25 are rejected under 35 U.S.C. 101 because the claims “recite a (mental) process.” Applicant respectfully submit that the claims are statutory under 35 U.S.C. 101 because claim 1 recites: “sending the associated recommended offering and an identification of a marketing channel computer to the client electronic device and sending a notification to the marketing channel computer,” which transforms the client electronic device and the marketing channel computer into a different state, so claim 1 is statutory under 35 U.S.C. 101. Further, claim 1 recites: “A computer implemented method comprising:” “receiving,” “comparing,” and “sending” elements, so the claims are restricted to a computer that implements “receiving,” “comparing,” and “sending” elements. Further, claim 1 recites: “the client electronic device displays the associated recommended offering via an output device,” so the output device is transformed to a different state. Claims 2-5 and 22-25 are statutory under 35 U.S.C. 101 for depending on claim 1.

Claim Rejections under 35 U.S.C. 102

Claims 1-5 and 22-25 are rejected under 35 U.S.C. 102(e) as anticipated by Birkholz (U.S. Patent No. 7,055,149 B2). Applicant respectfully submits that the claims are patentable over Birkholz because Birkholz does not teach or suggest all elements of the claims for the reasons argued below.

Claim 1 recites: “one of the plurality of conditions specifies a determination whether the trend at the client electronic device is increasing during the estimated time period,” which is not taught or suggested by Birkholz for the reasons argued below.

In contrast to claim 1, Birkholz at column 11, lines 66-67 and column 12, lines 1-17 recites: “The recommendation table 310 is a result of the system sizer process 310. It represents one or more systems with resources capable of handling the requirements. FIG. 8 shows one embodiment of a record 812 contained in the recommendation table 310. Illustratively, the record 812 comprises several key data elements including a user entry 814, an estimated system attributes entry 816, and a time period entry 818. . . . The time period indicates whether the estimated system meets the current requirements or for a future point in time (e.g., 12 months) as selected by the system sizer user.”

Thus, the Birkholz “time period indicates whether the estimated system meets the current requirements or for a future point in time,” so the Birkholz uses its “time period” to determine whether its “estimated system” meets its “current requirements” or its requirements “for a future point in time” and not whether Birkholz’s current system meets its current requirements or its requirements for a future point in time, so Birkholz does not teach or suggest “one of the plurality of conditions specifies a determination whether the trend at the client electronic device is increasing during the estimated time period,” as recited in claim 1 because claim 1 uses the “estimated time period” to determine whether the “trend at the client electronic device is increasing” and not whether a trend at a “recommended offering” is increasing.

Claim 1 further recites: "the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering, and wherein the client electronic device displays the associated recommended offering via an output device," which is not taught or suggested by Birkholz for the reasons argued below.

In contrast to claim 1, Birkholz at column 15, lines 51-66 and column 16, lines 1-9 recites: "FIG. 18 shows a system recommendation GUI 1800. The GUI 1800 contain system recommendation information resulting from the recommend table and which will be passed to the comparison tool 202. Illustratively, from the set of all computer systems capable of supporting the specified workload, one system is shown (indicated as "immediate solution"). Additionally, a system adapted to the growth trend is shown (indicated as "growth solution"). The system information which may be displayed to the user for each solution includes model/feature, processor CPW, interactive CPW, database capacity, N-Way, processor utilization, software pricing tier and memory. The model/feature information is the selected system identification. Clicking a drop-down menu button 1802 provides a menu of all models capable of performing the specified work. The processor CPW is the computing capacity of the processor and the interactive CPW is the computing capacity of the processor with interactive applications and percentage of that capacity used. The database capacity is the percentage of the overall CPU to used perform database processing. The N-Way is the number of processors in this model. Processor utilization is the percentage of overall CPU consumed by the workloads defined. Software pricing tear is an ID of a group determining pricing for software and support. The memory indicates the amount of memory and (RAM) required and the maximum amount the system supports."

Thus, Birkholz at Fig. 18 describes its "system recommendation" and not the Birkholz current system, so Birkholz does not teach or suggest "the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering," as recited in claim 1 because

the claim 1 “data comprises an inventory of components installed at the client electronic device” and not an inventory of the recommended offering.

In further contrast to claim 1, Birkholz at column 26, lines 66-67 and column 27, line 1 recites: “FIGS. 38-46 show illustrative embodiments of graphical user interfaces (GUIs) configured for facilitating a software upgrade request.” Thus, the sentence: “Why should I use IBM Electronic Services” in Fig. 38 refers to services that facilitate a software upgrade request and not a reason why a software upgrade was made because the Birkholz “Electronic Service” facilitates the Birkholz “software upgrade request” and is not the Birkholz “system recommendation,” so Birkholz does not teach or suggest “the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering,” as recited in claim 1.

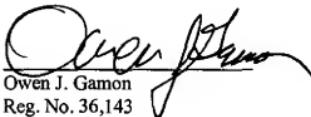
Claims 2-5 and 22-25 are dependent on claim 1 and are patentable over Birkholz for the reasons argued above, plus the elements in the claims.

**Conclusion**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is requested. The Examiner is invited to telephone Applicant's attorney (651-645-7135) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 09-0465.

Respectfully submitted,



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